REMARKS

Entry of the foregoing amendments and reconsideration of this application is requested. By this amendment, the specification and claims 15, 17, 18, 22 and 23 have been amended to more specifically set forth the invention. Claims 15-19, 21-24, 26 and 27 remain pending in the application. Support for this amendment may be found *inter alia* in Applicants' drawings, claims and specification (*specifically pg. 4, line 15 - pg. 5, line 9; pg. 6, lines 18-20; pg. 11, line 10 - pg. 14, line 24; and pg. 25, line 3 - pg. 27, line 29*); accordingly, no new matter has been introduced.

Objections

The Examiner has noted use of the trademark TRITON® X-100 in the application and requested applicants to correct instances where capitalization was not used to reflect the proprietary nature of the mark. In response, the applicant has amended the specification on page 18 to note use of the term TRITON® X-100 as a trademark, and accompanied it by its generic terminology. It is believed that this amendment to the specification overcomes the Examiner's objection.

35 U.S.C. §112

The Examiner has rejected claim 15-19, 21-24, 26, and 27 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) at the time the application was filed, had possession of the claimed invention. The Examiner states that claims 15-22, and claims depending therefrom, have been interpreted as encompassing embodiment where any voltage is used, taking on any configuration and having from two to an infinite number of electrodes, and as encompassing the electrodes coming into contact with the substrate and/or buffer and/or sample.

In response the applicants, have amended claims 15 and 22 to narrow the breadth of the claims and specifically state the inclusion of two to six electrodes, that are separated from one another, separated from the microlocation(s) and separated from the buffer, but positioned so as to create an electric field in the range of 200 volts/cm to 10,000 volts/cm. Support for these amendments can be found in the specification as pointed out by the Examiner. No new matter has been added by the amendments to claims 15 and 22. It is believed that these amendments overcome the 35 U.S.C. 112 rejections and place the claims in a condition for allowance. Notice to that effect is respectfully requested..

Next, the Examiner has rejected claims 15-19, 21-24, 26 and 27 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner asserts that claims 15 and 22 have been interpreted as encompassing embodiments where a "buffer" is provided and it "surrounds" the area of the sample, yet is not in contact with the sample. The applicant in response has amended claims 15 and 22 to state that the buffer is present on said microlocation(s) and is therefore in contact. The applicant has deleted use of the terms "surrounding" the microlocation(s). It is believed that this amendment clarifies the buffer as being in contact and thus overcomes the 35 U.S.C. 112 rejection and places the claims in a condition for allowance.

Finally, the Examiner has stated that claims 15 and 22 require the DNA sample be "transported" to the nucleic acid probes. The Examiner asserts that as presently worded, only one DNA probe need be present and the sample is placed on the probes. The applicant has amended claims 15 and 22, and claims 17 and 23 to reflect the change in claims 15 and 22, respectively. Claim 15 has been amended to state the steps of applying a sample comprising DNA to each of said microlocation(s); and applying a charge to said electrodes such that said sample comprising DNA applied to each of said microlocation(s) is transported to said DNA probe present at each of said microlocation(s) under conditions sufficient for hybridization to occur. Claim 22 has been amended to state the steps of applying a sample comprising DNA to said microlocation(s); applying charge to said electrodes such that said sample comprising DNA applied to one or a plurality of said microlocation(s) is transported to said DNA probe present on said substrate at each of said microlocation(s) under conditions sufficient for hybridization to

occur; and applying charge to said electrodes such that at least one DNA component corresponding to said sample comprising DNA applied to said microlocation(s) that is not hybridized with said DNA ~~probes~~ probe present on said substrate at each of said microlocation(s) is transported away from said DNA probe present on said substrate at each of said microlocation(s). It is believed the amendments to claims 15 and 22 to state these steps overcomes the Examiner's rejections with regard to enabling the transport of a DNA sample. Notice to that effect is respectfully requested.

No amendment made herein was related to the statutory requirements of patentability unless expressly stated; rather any amendment not so identified may be considered as directed *inter alia* to clarification of the structure and/or function of the invention and Applicants' best mode for practicing the same. More specifically, the method-based claims of the instant application have been amended herein to better conform them to the device-based claims previously elected in Restriction of the corresponding parent application; the same claims having already issued to Applicants in U.S. Patent No. 6,238,909. Additionally, no amendment made herein was presented for the purpose of narrowing the scope of any claim, unless Applicants have argued that such amendment was made to distinguish over a particular reference or combination of references. Furthermore, no election to pursue a particular line of argument was made herein at the expense of precluding or otherwise impeding Applicants from raising alternative lines of argument later during prosecution and/or Appeal. Applicants' failure to affirmatively raise specific arguments is not intended to be construed as an admission to any particular point raised by the Examiner.

The Applicant believes that the subject application, is in condition for allowance. Such action is earnestly solicited by the Applicant. In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicant's attorney or agent at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection.

SUMMARY: Reconsideration is respectfully requested. In view of the foregoing amendments and remarks it is believed that the application, including claims 15-19, 21-24, 26 and 27, is now in condition for allowance. Notice to that effect is respectfully requested.

Authorization is hereby given to charge any fees necessitated by actions taken herein, including any extension of time fees, to Deposit Account 502117.

Respectfully submitted,

William E. Koch
Attorney for Applicant
Reg. No. 29,659
Tel. (602) 952-3628

SEND CORRESPONDENCE TO:

MOTOROLA, INC.
Law Department
Customer Number: 23330